

### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on February 14, 2003, and the references cited therewith.

No claims are amended, added or canceled; as a result, claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 44-51 remain pending in this application.

#### §103 Rejection of the Claims

Claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 45-51 were rejected under 35 USC § 103(a) as being unpatentable over Matthews (US 6,025,837) in view of Norsworthy (US 6,144,402), Ohga (US 5,465,385) and Marsh (US 6,208,799). Applicant does not admit that Norsworthy and Marsh are prior art, and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are patentable over the cited art for the reasons argued below.

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection there is no motivation to combine the references in the manner suggested in the Office Action and because the claims contain elements not found in the cited references.

There is no motivation to combine the cited references in the manner suggested in the Office Action. For example, with respect to Matthews and Norsworthy, the Office Action states that the motivation to combine would be "at least in order to more efficiently utilize the bandwidth of a TV channel, as taught by Norsworthy, (col. 2, lines 26-44)." Applicant respectfully submits that Norsworthy provides no such motivation. Norsworthy is directed to an entirely different problem than the problems solved in the other cited references and to the

problem solved by Applicant's invention. Norsworthy is directed to providing additional bandwidth for data transmission in unused broadcast bandwidth (see column 2, lines 34-37). Norsworthy does not appear to relate to efficient use of that bandwidth, rather it is an alternative source of bandwidth. In fact, efficiency would appear not to be an issue in Norsworthy because of the available bandwidth.

Furthermore, none of the cited references can make use of the additional bandwidth provided in Norsworthy. Because they use broadcast bandwidth already allocated, there is no need for the additional bandwidth provided by Norsworthy. As a result, there is no motivation to combine Norsworthy with Matthews or any of the other cited references. Because there is no motivation to combine Norsworthy with Matthews, a *prima facie* case of obviousness has not been established. Applicant respectfully requests the withdrawal of the rejection of claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 45-51.

Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Finally, the Examiner must avoid hindsight. *Id.* The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The Office Action uses four references in the rejection of each grouping of claims. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from four references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

Additionally, with respect to claims 10 and 18 the Office Action took official notice “that at the time the invention was made, providing a subscriber with options for transmission times for deliver [sic] of data was known in the art.” Applicant respectfully traverses this official notice and requests the Examiner to provide a reference that describes such an element. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

With respect to claim 30, the Office Action states that in Norsworthy, the scheduling data is transmitted over a modem. This is different from Applicant’s claim 30, which recites that the “scheduled time and the scheduled channel from information received from one of the plurality of channels.” A modem is not one of a plurality of channels. Additionally, the Office Action states that Ohga teaches at column 1, lines 45-50 and at column 4, lines 11-15, that the scheduling information is transmitted over a CATV channel. The scheduling information in Ohga is the EPG data itself, not a schedule and channel where the EPG data can be retrieved. As a result, Ohga does not teach the recited language.

With respect to claim 45, the Office Action states that the claimed feature of executing multiple executions of the caching process is broad enough to read on Matthews and Norsworthy, since the user is enabled to choose and execute multiple broadcast programs. No citation of an element or elements in either Matthews or Norsworthy was provided. Applicant has reviewed Matthews and Norsworthy and can find no reference of scheduling multiple executions of the caching process as recited in claim 45. Choosing and executing multiple broadcast programs is different from scheduling multiple executions of the caching process. As a result, the cited references do not teach each and every element of claim 45. Withdrawal of the rejection of claim 45 is respectfully requested.

Claim 44 was rejected under 35 USC § 103(a) as being unpatentable over Matthews, Norsworthy, Ohga and Marsh, as applied to claim 1 above, and further in view of Klosterman (US 5,550,576). As discussed above, there is no motivation to combine Norsworthy with the other cited references. Therefore, no *prima facie* case of obviousness exists with respect to claim 44. The Examiner is respectfully requested to withdraw the rejection of claim 44.

Additionally, five references were used in this rejection. As discussed above, this is highly suggestive of using Applicant's disclosure as a template for a hindsight reconstruction of the present invention.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 14<sup>th</sup> day of May, 2003..

Name

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